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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,053	01/16/2002	Lee L. Swanson	3395-US	2780
21378 7590 08/20/2010 APPLIED MEDICAL RESOURCES CORPORATION 22872 Avenida Empresa Rancho Santa Margarita, CA 92688				
EXAMINER YABUT, DIANE D				
ART UNIT		PAPER NUMBER		
3734				
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08/20/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/053,053

**Applicant(s)**

SWANSTROM, LEE L.

**Examiner**

DIANE YABUT

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 10, 12-19, 21-40, 42-50, 60 and 61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 12-19, 21-40, 42-50, 60 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to applicant's amendment received on 06/02/2010.

The examiner acknowledges the amendments made to the claims. New claim 61 is addressed in paragraph 11, page 15 below.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 10, 12-19, 21-39 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claims 1-3, 10, 12-19, 21-39 and 61 there is an inconsistency in the language of the preamble and that of body of the claim thus making their scope unclear. The preamble recites "An apparatus for installing an implant" (in claim 1) and "A removable expansion assembly for dilating a stentless endograph" (in claim 60, which claim 61 depends upon) with the implant/stentless endograph only functionally recited, e.g. for installing/dilating, thus indicating that the claims are directed to the subcombination, an apparatus or assembly. However the last line of claim 1 positively recites the implant, and the second line of claim 61 positively recites the stentless endograph as elements of the invention, thus indicating that the claims are directed to the combination of the apparatus and the implant and the combination of the assembly and the stentless endograph. As such it is unclear whether applicant intends the claims to be drawn to the

combination or the subcombination. Applicant is hereby required to indicate which, the combination (the apparatus and the implant; the assembly and the stentless endograph) or subcombination (the apparatus; the assembly) the claims are intended to be drawn and make the language consistent with this intent. For examination purposes, the claims will be considered as drawn to the combination, the apparatus and the implant; the assembly and the stentless endograph.

### ***Response to Arguments***

4. Applicant's arguments filed 06/02/2010 have been fully considered but they are not persuasive.
5. Applicant generally argues that Lenker does not disclose the implant **P** being disposed around the struts **342** but rather the implant is disposed within the struts (Figures 23A-23B). However, the implant **P** may be considered to be "disposed around" the plurality of peripheral struts **342**, or "positioned near" the plurality of peripheral struts before and just after the implant is released, and therefore reads on the limitation. Also, in regards to claims 40 and 42-50, since applicant does not positively recite the implant, the struts being capable of being removably disposed within a surgical implant is met by the combination of Lenker and Cox.
6. Applicant also argues that modifying Hughes and Swanstrom with Lenker would not allow the expansion characters of the implant if it was free of mechanical structure. The examiner disagrees. The claim limitation does not recite a prosthesis free of mechanical structure, but rather a sleeve free of mechanical structure, which Hughes

teaches. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker and Swanstrom's implant assembly to include Hughes' tubular sleeve since such a modification would ensure long-term stability of the implant and reduce infection.

7. Lastly, applicant argues that modifying Lenker and Swanstrom with Levinson would prevent Lenker's struts from springing radially apart. The examiner disagrees. The cap **344** may still be able to move distally with respect to the struts due to movable shaft **350**, as well as proximally, as taught by Levinson, in order to expand the struts, and therefore the modification is proper.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 12, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenker et al., hereinafter "**Lenker**" (U.S. Patent No. **6,350,278**) in view of **Swanstrom** (WO 99/33402).

Lenker discloses a delivery device for positioning a intraluminal prosthesis in a vessel wall of an organ comprising an expansion assembly with proximal ends of struts **342** being free of mechanical connection that are captured within a cap or means for collapsing expansion assembly **344** in a first position, and wherein said proximal ends

are released from said cap in a second position, with means for dilating the expansion assembly and central strut **350** expands a portion of said implant against said vessel wall (Figures 23A-23B). The implant **P** is "disposed around" the plurality of peripheral struts **342**, or positioned near the plurality of peripheral struts before and just after the implant is released.

Lenker does not expressly disclose fastening said portion of said implant to said vessel wall of said organ while said expansion assembly holds said portion against said vessel wall, including a means for fastening

In Figures 4-7 Swanstrom teaches means for fastening including a fastener member **8** adapted to be inserted with an implant **3**, at least one flexible tie connector **9** extending from the fastener member, needle means **17** for containing said fastener member and flexible tie connector (needle **17** contains a portion of flexible tie connector at slot 19), means for driving said needle means through the exterior of said vessel wall to pierce said vessel wall and said implant, said means for driving including an endosurgical tool, push rod **20** or means for discharging said fastener member from said needle means into the interior of said implant, said at least one flexible tie connector including an external portion extending from said fastener member exteriorly of said vessel wall, and means for applying tensile force to said external portion of said at least one flexible tie connector, whereby said implant and said vessel wall are clamped together between said fastener member and said external portion of said at least one flexible tie connector (see abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to provide a means for fastening the implant of Lenker to the vessel wall, as taught by Swanstrom, in order to prevent migration of the implant or leaks and to effectively secure the implant to the target wall to prevent inadvertent disengagement (page 4 line 29 to page 5 line 12).

3. Claims 2, 15, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**) in view of **Swanstrom** (WO **99/33402**), as applied to claim 1 above, and further in view of **Hughes et al.** (U.S. Patent No. **4,728,328**).

The combination of Lenker and Swanstrom disclose the limitations as shown above. The combination does not disclose the following limitations, but Hughes et al. as shown do:

- said implant comprises a tubular, sleeve-like component free of mechanical structure (Fig 1).
- wherein said tubular, sleeve-like component includes at least one cuff (14) formed at a proximal end thereof;
- wherein said tubular, sleeve-like component includes at least one cuff (14) formed at one end thereof;
- wherein said at least one cuff includes an end portion (18) of said tubular, sleeve-like component folded retroflexively to impinge on the exterior of said component (Fig 1 );

It would have been obvious to a person having ordinary skill in the art at the time

the invention was made to modify Lenker and Swanstrom's implant assembly to include Hughes' tubular sleeve. Such a modification would ensure long-term stability of the implant and reduce infection.

4. Claims 3 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**), **Swanstrom** (WO **99/33402**), and **Hughes et al.** (U.S. Patent No. **4,728,328**), as applied to claim 2 and 15 above, and further in view of **Cox et al.** (U.S. Pub. No. **2003/0023301**).

The combination of Lenker/Swanstrom/Hughes disclose the limitations as shown above. The combination does not disclose the following limitations, but Cox et al. as shown do:

- said removable expansion assembly is disposed to translate concentrically within said tubular, sleeve-like component free of mechanical structure (Fig 1 )
- a catheter assembly having a first tube (Fig 1, #20);
- said first tube includes a lumen (Fig 1, #20) adapted to receive said tubular, sleeve-like component, said first tube having a diameter dimensioned so that the proximal end of said first tube engages said cuff in end-abutting relationship;
- said tubular, sleeve-like component is disposed in said lumen in a radially contracted state (Fig 1);
- said catheter assembly includes a second tube disposed for axial translation concentrically within said first tube (Fig. 1, #11 ), said second tube having a proximal end dimensioned to engage the distal end of said tubular, sleeve-like component in end-



abutting relationship.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker, Swanstrom, and Hughes' implant assembly to include Cox's catheter and tubes. Such a modification would protect the vessel from abrasion by the expansion member and force the implant out of the sleeve. The limitations following the phrases "adapted to" and "dimensioned to" are considered to be functional language and thus require nothing more than the ability to so perform.

5. Claims 10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**) and **Swanstrom** (WO **99/33402**), as applied to claim 1 above, and further in view of **Levinson et al.** (U.S. Patent No. **6,537,296**). Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** in view of **Swanstrom** (WO 99/33402) and **Levinson et al.** (U.S. Patent No. **6,537,296**).

Lenker and Swanstrom disclose the claimed device, including an endograph except for the struts being urged in a proximal direction in order to thereby compress the peripheral struts axially by impinging on the proximal ends, and the expansion assembly being received within a confinement tube.

Levinson et al. teach a plurality of peripheral struts **10** with proximal ends (near **40**) and distal ends (near **46**), and a stop **16** mounted on a central strut **12** slidably disposed within said tube, wherein said stop is movable between a first position, wherein said proximal ends are abutting said stop, wherein the stop impinges on said proximal ends to compress struts axially, and a second position wherein said proximal

ends are not abutting said stop, a means for dilating **44** said expansion assembly against said vessel wall and means for collapsing said expansion assembly (Figures 27A-C). The expansion assembly may be received within a confinement tube or catheter **48** (Figure 9). It would have been obvious to one of ordinary skill in the art at the time of invention to provide struts being urged in a proximal direction in order to thereby compress the peripheral struts axially by impinging on the proximal ends, as taught by Levinson et al., to Lenker and Swanstrom in order to selectively collapse and expand the assembly if desired.

6. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**), **Swanstrom** (WO **99/33402**), and **Hughes et al.** (U.S. Patent No. **4,728,328**), as applied to claim 2 above, and further in view of **Trescony et al.** (U.S. Patent No. **5,653,745**).

The combination of Lenker/Swanstrom/Hughes disclose the limitations as shown above. The combination does not disclose the following limitations, but Trescony et al. as shown do:

- said tubular sleeve-like component (Fig. 1, #10) includes means for increased longitudinal stiffness (col. 3, In 56-67);
- wherein said means for increased longitudinal stiffness includes a plurality of stiffener struts or pleats (Fig. 1, #12) extending longitudinally in said tubular, sleeve-like component (Fig. 1 ).

NOTE: Trescony teaches pleats extending longitudinally (Fig 1). Due to the substantially

similar structure of the reference and the Applicant's implant, the Examiner considers the pleats to increase longitudinal stiffness. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker, Swanstrom, and Hughes' implant assembly to include Trescony's pleats. Such a modification would provide longitudinal support reducing stretching, making the implant more durable.

7. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**), **Swanstrom** (WO 99/33402), and **Hughes et al.** (U.S. Patent No. **4,728,328**), as applied to claim 25 above, and further in view of **Chevillon et al.** (U.S. Patent No. **6,248,116**)

The combination of Lenker/Swanstrom/Hughes disclose the limitations as shown above. The combination does not disclose the following limitations, but Chevillon et al. as shown do:

- further including at least one reinforcing band (Fig. 1, #140a) incorporated in said at least one cuff;
- said at least one reinforcing band is resiliently (col. 7, In 1-3) biased to expand radially outwardly (Fig. 1, #140a).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker, Swanstrom, and Hughes' implant assembly to include Chevillon's bands. Such a modification would reinforce the implant against the vessel wall.

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**), **Swanstrom** (WO **99/33402**), and **Hughes et al.** (U.S. Patent No. **4,728,328**), as applied to claim 2 above, and further in view of **White et al.** (U.S. Pub. No. **2006/0015176**).

The combination of Lenker/Swanstrom/Hughes disclose the limitations as shown above. The combination does not disclose the following limitations, but White et al. as shown do:

- said implant has a Y-configuration (Fig 9);
- wherein one branching end of said Y-configuration comprises an elongated tubular leg (Fig. 9, #28);
- wherein one branching end of said Y-configuration comprises a short connector leg (Fig 9, #29).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker/Swanstrom/Hughes. Such a modification would be used for placement in a bifurcated blood vessel.

9. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**) in view of **Swanstrom** (WO **99/33402**), as applied to claim 36 above, and further in view of **Haber et al.** (U.S. Patent No. **5,201,743**).

The combination of Lenker and Swanstrom disclose the limitations as shown above.

The combination does not disclose the following limitations, but Haber et al. as shown do:

- said means for applying tensile force include means for winding said at least one flexible tie connector about a winding axis (Fig. 6, #118).
- said means for winding including a torque-limiting mechanism (Fig. 6; col. 4, ln 8-20);
- said means for winding includes an endosurgical tool (Fig 6).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker and Swanstrom's implant assembly to include Haber's means for winding. Such a modification would secure the fastener to the tissue.

10. Claims 40 and 42-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** (U.S. Patent No. **6,350,278**) in view of **Cox et al.** (U.S. Pub. No. **2003/0023301**).

Claim 40: Lenker discloses the limitations as shown above and further disclose:

- a plurality of peripheral struts (Fig. 23B, #342),
- said struts having a relaxed state in which said peripheral struts extend generally parallel to a longitudinal axis and are spaced angularly thereabout (Fig. 23B, #342),
- said peripheral struts include proximal ends, said proximal ends being free of mechanical connection (Fig 23B);
- means for urging (350) said peripheral struts to a bowed state; Lenker disclose urging

mechanism (350) that is capable of urging the struts into a bowed state when pulled back against the struts (342); wherein

- said peripheral struts (342) expand radially outwardly from said longitudinal axis, to thereby dilate said surgical implant (Fig. 23B, element P).

Lenker also discloses said plurality of peripheral struts #342 being removably disposed within said surgical implant, or within the lumen of the implant P (Figure 23B).

Claims 42-48: Lenker discloses the limitations as shown above and further disclose:

- said peripheral struts include like distal ends, said distal ends being secured together (Fig 23A).
- said means for urging said peripheral struts includes means for compressing said peripheral struts along said longitudinal axis to effect bowing of said peripheral struts radially outwardly from said longitudinal axis (Fig. 23B). Note that Lenker discloses urging mechanism (350) that is capable of urging the struts into a bowed state when pulled back against the struts (342);
- said means for compressing includes an end cap (344), said end cap including means for releasably impinging on said proximal ends of said peripheral struts (Fig 23A-B).
- a central strut (see Fig. 23A-B) extending parallel to said peripheral struts, said central strut being secured to said end cap (Fig. 23B, #344 and #350).
- means for translating said central strut distally to urge said end cap to impinge on said proximal ends of said peripheral struts and compress said peripheral struts axially (Fig 23B).
- said means for releasably impinging includes a recess formed in a distal surface of

said end cap (Fig 23A).

- means for translating said peripheral struts distally (Fig. 23A-B) along said longitudinal axis to move said proximal ends of said peripheral struts distally with respect to said end cap (see Fig. 23A-B).

Claims 49-50: Lenker does not disclose the following limitations, but Cox et al. as shown do:

- a confinement tube (Fig. 1-3, #20), said confinement tube having a lumen dimensioned to receive said peripheral struts in a non-expanded, radially-collapsed state (see Fig. 1-3; paragraph [0042]);
- said confinement tube is translatable with respect to said peripheral struts to move said confinement tube selectively into concentric confinement of said peripheral struts (paragraph [0042]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lenker's expansion assembly to include Cox's tube assembly. Such a modification would protect the vessel from abrasion by the expansion member.

The Examiner notes that although the Lenker reference discloses the implant within the expansion member, it is common in the art as shown by the Cox reference to dispose the implant on the exterior of the expansion member. Because the Lenker assembly is fully capable of expanding an implant, the Examiner considers the Cox reference to teach how this would be achieved.

11. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lenker** in view of **Swanstrom** (WO 99/33402) and **Levinson et al.** (U.S. Patent No. **6,537,296**), as applied to claim 60 above, and further in view of **Taheri** (U.S. Patent No. **6,723,116** ).

Lenker, Swanstrom, Levinson disclose an endograph or endograft (Lenker, col. 2, lines 35-49) but not a stentless endograph.

Taheri teaches a graft without a stent (col. 1, lines 48-52). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a stentless graft, as taught by Taheri, to Lenker, Swanstrom, Levinson, since applicant has not disclosed that having an endograph without a stent solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a stentless endograft that may still be expandable when delivered.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In Figures 10a-d **Berry et al.** (U.S. Patent No. **5,702,419**,) discloses an prosthesis **10** that is disposed over expansion struts **42** which are disposed within the lumen of the prosthesis.



13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/  
Examiner, Art Unit 3734

/TODD E. MANAHAN/  
Supervisory Patent Examiner, Art Unit 3734